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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,337	09/16/2003	Keiko Shiraishi	117194	9255
25944	7590	01/21/2010	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				PATEL, MANGLESH M
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/662,337	SHIRAISHI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	MANGLESH M. PATEL	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 22 October 2009.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-17 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-17 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____ .	6) <input type="checkbox"/> Other: _____ .

**DETAILED ACTION**

1. This FINAL action is responsive to the amendment filed on 10/22/2009.
2. In the amendment claims 1-17 remain pending. Claims 1, 10, 11, 12, 13, 16 and 17 are the independent claims.

**Withdrawn Rejections**

3. The 35 U.S.C. 102(a) rejections of claims 1-17 with cited reference of Lee (U.S. 6,782,379) has been withdrawn in light of the amendment.

**Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (U.S. 6,782,379, filed Nov. 30, 2001) in view of Shore (U.S. 6,564,193, filed May 13, 2003).

**Regarding Independent claims 1, 10, 13 and 16,** An instruction form retrieval apparatus comprising: A storage part that stores user information and information on an instruction form management apparatus that is connected to the instruction form retrieval apparatus via a network and is holding an at least one selectable instruction form associated with a user based on user access rights, wherein the instruction form is generated in advance, the instruction form and the user information being associated with each other wherein the instruction form including tags for at least one of scanning, printing, or faxing, and instructions and indicates a plurality of processing to be executed by a plurality of instruction form execution apparatuses, and is different than any file to be processed by the instructions; A reception part that receives information on a user; A retrieval part that retrieves the instruction form accessible to the user from the instruction form management apparatus based on the received information on the user. An output part that outputs identification information on the retrieved instruction form to allow the user to instruct performing a process indicated in the instruction form to one or more instruction form execution apparatuses connected to the instruction form retrieval apparatus via the network.

Lee discloses a storage part that stores user information and information on a management apparatus connected through a network (see fig 57 disclosing in numeral 2212 certificate Registration Module that authenticates a requesting User). The apparatus includes a selectable instruction form as templates and are based on user access rights as shown in fig 6 numeral 300 wherein the user requests access which is then intercepted by web pass. See column 7, lines 28-35 which discloses access privileges. Furthermore the Identity system holds selectable forms based on user access rights such as the certificate registration information (see column 9, lines 17-22). The instruction forms are the plurality of XML templates already generated in advance and which provide a plurality of instructions for the execution apparatuses or devices for displaying content (column 2, lines 15-45). He discloses an output part that outputs Identification information on the retrieved template (see column 26, lines 30-60). After authentication the system allows the user to create a workflow which includes identification information, the workflow or instructions is based on the template to determine which actions can be added. Therefore Lee teaches an output part that outputs identification information (as an ID associated with the workflow generated from the instruction form) thereby allowing the user to instruct performing a process such as actions defined in the templates. Lee fails to explicitly teach the use of tags for printing scanning or faxing. Shore discloses an internet based system for transmission of facsimile messages. The system includes fax servers that are web-based thereby being defined in a markup language and include tags for operating or executing facsimiles (column 3, lines 1-60). At the time of the invention it would have been obvious for one of ordinary skill in the art to have modified the teachings of Lee to include the web based facsimile service of Shore. The motivation for doing so would have been to provide a more secure web based facsimile service.

**Regarding Dependent claim 2**, with dependency of claim 1, Lee discloses wherein the output part outputs the Identification information on the retrieved instruction form to the instruction form execution apparatus used by the user (See abstract & column 2, lines 15-45, including the explanation provided in the independent claims).

**Regarding Dependent claim 3**, with dependency of claim 1, Lee discloses wherein the output part outputs the Identification information on the instruction form to a terminal used by the user (See abstract & column 2, lines 15-45, including the explanation provided in the independent claims).

**Regarding Dependent claim 4**, with dependency of claim 1, Lee discloses wherein the output part outputs a command to the instruction form management apparatus to transmit the instruction form accessible to the user to the instruction

form execution apparatus used by the user, based on the Identification information on the retrieved instruction form (See abstract & column 2, lines 15-45, including the explanation provided in the independent claims).

**Regarding Dependent claim 5**, with dependency of claim 1, Lee discloses wherein the output part outputs a command to the instruction form management apparatus to transmit the instruction form accessible to the user to a terminal used by the user, based on the Identification information on the retrieved instruction form (See abstract & column 2, lines 15-45, including the explanation provided in the independent claims).

**Regarding Dependent claim 6**, with dependency of claim 1, Lee discloses wherein the outputted Identification information on the retrieved instruction form is information on the instruction form management apparatus holding the instruction form (See abstract & column 2, lines 15-45, including the explanation provided in the independent claims).

**Regarding Dependent claim 7**, with dependency of claim 1, Lee discloses wherein the outputted Identification information on the retrieved instruction form includes information to identify the instruction form (See abstract & column 2, lines 15-45, including the explanation provided in the independent claims).

**Regarding Dependent claim 8**, with dependency of claim 1, Lee discloses wherein user authentication is performed using the information on the user (See abstract & column 2, lines 15-45, including the explanation provided in the independent claims).

**Regarding Dependent claim 9**, with dependency of claim 1, Lee discloses a display information generation part that generates information to display the information on the retrieved instruction form (See abstract & column 2, lines 15-45, including the explanation provided in the independent claims).

**Regarding Independent claims 11 and 12**, An instruction form execution apparatus comprising: an attachment part that attaches a portable storage , medium which is unique to and capable of being carried by a predetermined user, the storage medium holding information on a plurality of instruction form management apparatuses holding at least one selectable instruction form associated with the user based on user access rights, wherein the instruction form is generated in advance, wherein the instruction form including tags for at least one of scanning, printing, or faxing instructions and indicates a plurality of processing to be executed by a plurality of instruction form execution

apparatuses and is different than any file to be processed by the instructions; and an execution part that executes a plurality of processing instructions indicated in the instruction form, wherein the at least one selectable instruction form is located on at least one server.

Lee discloses a storage part that stores user information and information on a management apparatus connected through a network (see fig 57 disclosing in numeral 2212 certificate Registration Module that authenticates a requesting User). The apparatus includes a selectable instruction form as templates and are based on user access rights as shown in fig 6 numeral 300 wherein the user requests access which is then intercepted by web pass. See column 7, lines 28-35 which discloses access privileges. Furthermore the Identity system holds selectable forms based on user access rights such as the certificate registration information (see column 9, lines 17-22). The instruction forms are the plurality of XML templates already generated in advance and which provide a plurality of instructions for the execution apparatuses or devices for displaying content (column 2, lines 15-45). He discloses an output part that outputs Identification information on the retrieved template (see column 26, lines 30-60). After authentication the system allows the user to create a workflow which includes identification information, the workflow or instructions is based on the template to determine which actions can be added. Therefore Lee teaches an output part that outputs identification information (as an ID associated with the workflow generated from the instruction form) thereby allowing the user to instruct performing a process such as actions defined in the templates. Lee fails to explicitly teach the use of tags for printing scanning or faxing. Shore discloses an internet based system for transmission of facsimile messages. The system includes fax servers that are web-based thereby being defined in a markup language and include tags for operating or executing facsimiles (column 3, lines 1-60). At the time of the invention it would have been obvious for one of ordinary skill in the art to have modified the teachings of Lee to include the web based facsimile service of Shore. The motivation for doing so would have been to provide a more secure web based facsimile service.

**Regarding Dependent claim 14**, with dependency of claim 13, Lee discloses wherein the information on the retrieved instruction form is outputted to the instruction form execution apparatus used by the user (See abstract & column 2, lines 15-45, including the explanation provided in the independent claims).

**Regarding Dependent claim 15**, with dependency of claim 13, Lee discloses outputting a command to the instruction form management apparatus to transmit the instruction form accessible to the user to the instruction form execution

apparatus used by the user, based on the information on the retrieved instruction form (See abstract & column 2, lines 15-45, including the explanation provided in the independent claims).

**Regarding Independent claim 17,** An instruction form execution apparatus comprising: an attachment part that attaches a portable storage medium capable of being carried by a user that stores at least one selectable instruction form that includes processing instructions associated with the user based on user access rights, wherein the instruction form is generated in advance, wherein the instruction form including tags for least one of scanning, printing, or faxing, and indicating a plurality of processing to be executed by a plurality of instruction form execution apparatuses and is different than any file to be processed by the processing instructions; and a processing part that executes the processing instructions based on the instruction form to process information not stored in the storage medium.

Lee discloses a storage part that stores user information and information on a management apparatus connected through a network (see fig 57 disclosing in numeral 2212 certificate Registration Module that authenticates a requesting User). The apparatus includes a selectable instruction form as templates and are based on user access rights as shown in fig 6 numeral 300 wherein the user requests access which is then intercepted by web pass. See column 7, lines 28-35 which discloses access privileges. Furthermore the Identity system holds selectable forms based on user access rights such as the certificate registration information (see column 9, lines 17-22). The instruction forms are the plurality of XML templates already generated in advance and which provide a plurality of instructions for the execution apparatuses or devices for displaying content (column 2, lines 15-45). He discloses an output part that outputs Identification information on the retrieved template (see column 26, lines 30-60). After authentication the system allows the user to create a workflow which includes identification information, the workflow or instructions is based on the template to determine which actions can be added. Therefore Lee teaches an output part that outputs identification information (as an ID associated with the workflow generated from the instruction form) thereby allowing the user to instruct performing a process such as actions defined in the templates. Lee fails to explicitly teach the use of tags for printing scanning or faxing. Shore discloses an internet based system for transmission of facsimile messages. The system includes fax servers that are web-based thereby being defined in a markup language and include tags for operating or executing facsimiles (column 3, lines 1-60). At the time of the invention it would have been obvious for one of ordinary skill in the art to have modified the teachings of Lee to include the web based facsimile service of Shore. The motivation for doing so would have been to provide a more secure web based facsimile service.

It is noted that any citation [[s]] to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. [[See, MPEP 2123]]

**Response to Arguments**

6. Applicant's arguments filed 10/22/2009 have been fully considered but are moot in view of the new grounds of rejection. However arguments to Lee have been addressed below.

Applicant Argues: Lee fails to disclose feature 1 quoted above because Lee's templates, while being stored, are not stored in association with any user. (pg 10, paragraph 3)

Lee does not disclose that any templates have processing to be executed by a plurality of instruction form execution apparatuses. (pg 11, paragraph 2)

Lee does not disclose that the user must enter any information on the user to do so. (pg 11, paragraph 2)

Lee does not appear to disclose any portable storage medium storing information on apparatuses storing at least one instruction form associated with a user. (pg 11, paragraph 4)

Lee does not disclose that the location of the template is retrieved based on information on the user. (pg 12, paragraph 1)

The Examiner Respectfully Disagrees The Identity system retrieves and executes XML templates based on user request thereby being in association with a user since the user must be authorized to make the request (column 15, lines 10-25). The Execution apparatuses are the devices that display the content see column 2, lines 15-45. The user does infact enter information to login to the Identity system (see column 15, line 15-20). Lee discloses a portable storage medium containing the certificates associated with the user (see fig 2, numeral 62).

**It is not necessary that the references actually suggest, expressly or in so many words the changes or improvements that applicant has made. The test for combining references is what the references as a whole would have suggested to one of ordinary skill in the art. In re Scheckler, 168 USPQ 716 (CCPA 1971); In re McLaughlin 170 USPQ 209 (CCPA 1971); In re Young 159 USPQ 725 (CCPA 1968).**

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#### Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manglesh M. Patel whose telephone number is (571) 272-5937. The examiner can normally be reached on M, W 6 am-3 pm T, TH 6 am-2pm, Fr 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Manglesh M. Patel  
Patent Examiner (AU 2178)  
January 14, 2010

/Manglesh M Patel/  
Manglesh Patel  
Examiner, Art Unit 2178

	/CESAR B PAULA/ Primary Examiner, Art Unit 2178
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